From: Willis, Pam

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Subject: U.S. TRADEMARK APPLICATION NO. 86314468 - REWARDS GENIUS - N/A - Request for Reconsideration Denied - Return to TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION

U.S. APPLICATION SERIAL NO. 86314468

MARK: REWARDS GENIUS

CORRESPONDENT ADDRESS:

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GENERAL TRADEMARK INFORMATION:

http://www.uspto.gov/trademarks/index.jsp

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APPLICANT: Tango Card, Inc.

CORRESPONDENT'S REFERENCE/DOCKET NO:

N/A

CORRESPONDENT E-MAIL ADDRESS:

chaselibbey@verizon.net

REQUEST FOR RECONSIDERATION DENIED

ISSUE/MAILING DATE: 10/2/2015

The trademark examining attorney has carefully reviewed applicant's request for reconsideration and is denying the request for the reasons stated below. *See* 37 C.F.R. §2.63(b)(3); TMEP §§715.03(a)(ii)(B), 715.04(a). The following refusal made final in the Office action dated June 2, 2015 is maintained and continues to be final: refusal to register based upon Trademark Act Section 2(d) as to U.S. Reg. No. 4478749. *See* TMEP §§715.03(a)(ii)(B), 715.04(a).

In the present case, applicant's request has not resolved all the outstanding issues, nor does it raise a new issue or provide any new or compelling evidence with regard to the outstanding issue in the final Office action. In addition, applicant's analysis and arguments are not persuasive nor do they shed new light on the issues. Accordingly, the request is denied.

The examining attorney, in the first and final Office actions provided analysis, evidence, and case law establishing that a likelihood of confusion exists between applicant's mark REWARDS GENIUS and the registered mark GENIUS. First, the marks are similar in sound, appearance, and commercial impression. Second, the services that the marks identify are related.

Applicant argued in its request for reconsideration that the marks are different, and that the services are not similar/related. The examining attorney addressed both of those arguments in detail in the final Office action, and determined that a likelihood of confusion exists on all of the grounds detailed therein. Applicant further argued that the consumers of the respective services are sophisticated and would therefore, not experience confusion as to the source. The examining attorney disagrees with this assertion. The fact that purchasers are sophisticated or knowledgeable in a particular field does not necessarily mean that they are sophisticated or knowledgeable in the field of trademarks or immune from source confusion. TMEP §1207.01(d)(vii); *see, e.g.*, *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d. 1317, 1325, 110 USPQ2d 1157, 1163-64 (Fed. Cir. 2014); *Top Tobacco LP v. N. Atl. Operating Co.*, 101 USPQ2d 1163, 1170 (TTAB 2011).

Further, the services of the parties need not be identical or even competitive to find a likelihood of confusion. *See On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000); *Recot, Inc. v. Becton*, 214 F.3d 1322, 1329, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000) ("[E]ven if the goods in question are different from, and thus not related to, one another in kind, the same goods can be related in the mind of the consuming public as to the origin of the goods."); TMEP §1207.01(a)(i).

The respective services need only be "related in some manner and/or if the circumstances surrounding their marketing [be] such that they could give rise to the mistaken belief that [the goods and/or services] emanate from the same source." *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)); TMEP §1207.01(a)(i).

The examining attorney established, through the attachment of evidence in previous Office action that the services are at the very least related in that they both focus on electronic gift cards. As such, there is a likelihood of confusion in this case.

Given the analysis, evidence, and case law contained in the first and final Office actions and this response to applicant's request for reconsideration, it is clear that there is a likelihood of confusion between the marks in this case. Therefore, applicant's request for reconsideration is denied.

If applicant has already filed a timely notice of appeal with the Trademark Trial and Appeal Board, the Board will be notified to resume the appeal. *See* TMEP §715.04(a).

If no appeal has been filed and time remains in the six-month response period to the final Office action, applicant has the remainder of the response period to (1) comply with and/or overcome any outstanding final requirement(s) and/or refusal(s), and/or (2) file a notice of appeal to the Board. TMEP §715.03(a)(ii)(B); *see* 37 C.F.R. §2.63(b)(1)-(3). The filing of a request for reconsideration does not stay or extend the time for filing an appeal. 37 C.F.R. §2.63(b)(3); *see* TMEP §§715.03, 715.03(a)(ii)(B), (c).

/Pamela Y. Willis/

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